

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1 and 3-19 are pending in the application, with 1, 6, 7, 12 and 16 being the independent claims. Claims 1, 3-7, and 9 are sought to be amended. Claims 11-19 are sought to be added. Claim 2 is sought to be cancelled without prejudice or disclaimer of the subject matter therein. Applicants reserve the right to prosecute similar or broader claims, with respect to the cancelled and amended claims, in the future. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Finality of the Rejections

It is indicated in the current Office Action that the Action is final. Applicants respectfully disagree with the finality of the Action and request that it be reconsidered and withdrawn. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." *See*, M.P.E.P. § 706.07(a). Applicants note that the Examiner has introduced a new ground of rejection, i.e., the rejection of claims 7-10 under 35 U.S.C. § 103, that did not appear in the previous Office

Action, dated April 18, 2007. Furthermore, Applicants have not filed an amendment to claims 7-10 or an information disclosure statement since the Office Action of April 18, 2007. Thus, the new ground of rejection is neither necessitated by Applicants' amendment of the claims nor information in an information disclosure statement. Therefore, the finality of the current Office Action is premature. Accordingly, Applicants request that finality of the current Office Action be reconsidered and withdrawn.

During a telephone communication from the Examiner on November 16, 2007, the Examiner implicitly agreed that the rejection was prematurely a final, and stated that all amendments would be considered and entered as if filed in response to a non-final rejection and would allow the application, if the amendments and arguments made the claims allowable, or would issue a non-final Office Action as the next Office Action. Applicants thank the Examiner for this indication.

Rejection under 35 U.S.C. § 102

The Examiner has rejected claim 6 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Publication No. 2002/0099632 to Yanagidate *et al.* (hereinafter "Yanagidate"). For the reasons set forth below, Applicants respectfully traverse.

Claim 6 recites features that distinguish over the applied reference. For example, claims 6 recites:

a billing file generating device configured to generate a billing file comprising information for billing which includes the type of a transmitted packet unit, the number of transmitted packets, and a packet communication rate, with respect to an identification (ID) to be billed....

Yanagidate is directed to a method for employing a cable television (CATV) network as an IP network to provide an internet connection service. *See* Yanagidate, at Abstract. Yanagidate, in FIG. 1, provides a structural example of a CATV network employed as an IP network that includes: subscriber terminals 20, transmission path 1, bill charging device 30, customer information management service 32, WWW server 31, and the internet 4. *See* Yanagidate, paragraphs [0037]-[0039]. The Examiner states that the "billing data" stored in the bill charging device 30 of Yanagidate, as taught in paragraph [0041], is equivalent to the billing file recited in claim 6. The Examiner then goes on to equate the information stored in the billing file recited in claim 6, with features disclosed in Yanagidate. However, the features of Yanagidate that the Examiner relies on are not all stored within the same file, let alone the same device, as recited in claim 6. Yanagidate discloses no single file that stores each of these elements.

In addition, Yanagidate does not teach or suggest storing "the number of transmitted packets," as recited in claim 6, nor does the Examiner allege that this feature is taught by Yanagidate. In the event that the Examiner maintains the rejection of independent claim 6 under 35 U.S.C. § 102(e), Applicants respectfully request that the Examiner, in the interests of compact prosecution, identify on the record and with specificity sufficient to support an anticipation rejection, where in Yanagidate this feature of independent claim 6 is alleged to be taught. Currently, the Examiner has failed to identify where in Yanagidate the alleged anticipatory teaching is found.

Since Yanagidate does not teach or suggest each and every feature of claim 6, it cannot anticipate that claim. Accordingly, Applicants respectfully request that the rejection of claim 6 under 35 U.S.C. § 102(e) be reconsidered and withdrawn. Newly

added dependent claim 11 is similarly not anticipated by Yanagidate for at least the same reasons as claim 6, from which it depends, and further in view of its own respective feature. Accordingly, Applicants respectfully request favorable consideration of claim 11.

Rejection under 35 U.S.C. § 103

The Examiner has rejected claims 1-5 and 7-10 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,728,263 to Joy *et al.* (hereinafter "Joy") in view of Yanagidate. For the reasons set forth below, Applicants respectfully traverse.

Without acquiescing to the propriety of the rejection, Applicants have cancelled claim 2. Therefore, the rejection of this claim has been rendered moot.

Claim 1

Claim 1 recites features that distinguish over the applied references. For example, claim 1 recites (emphasis added):

a determining device configured to select a most appropriate packet unit for transmission data to be packetized that **minimizes** the amount of transmission data ...

The combination of Joy and Yanagidate does not establish a *prima facie* case of obviousness because the combination does not teach this distinguishing feature.

Joy is directed to a system and method for dynamically sizing packets of data in a network. In particular, Joy describes the dynamic sizing of packets to improve the application of audio and video conferencing over a network. *See* Joy, col. 1, ll. 5-18. Joy purports that by adjusting the size of a data packet to be as small as possible—given the bandwidth of the client to receive the data packets—"there is less latency, that is,

there is less delay from the transmission of the data . . . , and ultimate receipt and playback of the data by the client computer." *See* Joy, col. 1, ll. 30-34. However, by decreasing the size of the data packets, more data packets need to be sent in order to convey the same amount of information. This, coupled with the fact that the header portion of each data packet stays substantially the same in size, results in more bandwidth necessary to transmit the same amount of data in the same amount of time (due, at least in part, to the increased number of headers needed to be transmitted). *See* Joy, col. 1, ll. 34-37.

As noted above, by reducing the size of the data packet in Joy, the overall amount of transmission data to be sent is **increased**. The distinguishing features of claim 1, noted above, are in contrast to this teaching in Joy. Not only does Joy fail to teach each and every feature of claim 1 but, in fact, teaches away from the presently claimed features.

Joy does not teach or suggest each and every feature of independent claim 1. Yanagidate is used on page 4 of the present Office Action to teach selecting packets recognized by a destination communication terminal device. Even assuming this is a correct interpretation by the Examiner, which Applicants do not acquiesce to, Yanagidate does not provide the missing teaching or suggestion with respect to claim 1. Consequently, the combination of Joy and Yanagidate cannot render independent claim 1 obvious. Dependent claims 2-5 are likewise not rendered obvious by the combination of Joy and Yanagidate for the same reasons as independent claim 1, from which they depend, and further in view of their own respective features. Accordingly, Applicants

respectfully request that the rejection of claims 1-5 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claim 7

Independent claim 7 recites features that distinguish over the applied references. For example, similar to claim 1, claim 7 recites “selecting a packet unit, recognizable by said destination communication device, to minimize the amount of transmission data.”

For reasons discussed above with respect to claim 1, Joy does not teach or suggest this distinguishing feature. As also discussed above with respect to claim 1, Yanagidate does not provide the missing teaching or suggestion. Accordingly, the combination of Joy and Yanagidate cannot render independent claim 7 obvious.

Dependent claims 8-10 are likewise not rendered obvious by the combination of Joy and Yanagidate for the same reasons as claim 7, from which they depend, and further in view of their own respective features. Accordingly, Applicant respectfully requests that the rejection of claims 7-10 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

New Claims 12-19

New independent claims 12 and 16 recite features that distinguish over the applied references, including distinguishing features that are similar to those recited in independent claims 1 and 7. For example, claims 12 and 16 are method and system based, respectively, computer program product claims, including “selecting a packet unit recognizable by said destination communication device to minimize an amount of transmission data for said packet unit based on data communication rates,” as recited in claim 12 and “selecting means for enabling the processor to select a packet unit recognizable by said destination communication device to minimize an amount of

transmission data for said packet unit based on data communication rates,” as recited in claim 16.

Based on at least these distinguishing features, Applicants respectfully request favorable consideration of claims 12 and 16. New dependent claims 13-15 and 17-19 depend from claims 12 and 16, respectively. Dependent claims 13-15 and 17-19 are similarly patentable for the same reasons as claims 12 and 16, from which they depend, and further in view of their own respective features. Accordingly, Applicants respectfully request favorable consideration of claim 13-15 and 17-19.

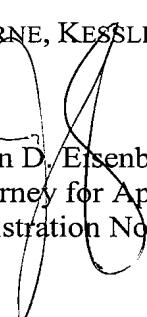
Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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